

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#39
(NE)

In re application of

Adang et al

Appln. No. 7/713,624

Group Art Unit: 1804

Filed: June 10, 1991

Examiner: Dr. Che Chereskin

For: INSECT RESISTANT PLANTS

FYI

INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §§ 1.97 and 1.98

JUL 1 1994

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

RECEIVED IN
BOX INTERFERENCE

Sir:

In accordance with the duty of disclosure under 37 CFR §1.56, Applicant hereby notifies the U.S. Patent and Trademark Office of the documents which are listed on the attached Form PTO-1449 listed herein and which the Examiner may deem relevant to patentability of the claims of the above-identified application.

One copy of each of the listed documents is submitted herewith.

The present Information Disclosure Statement is being filed (without a Certification under 37 CFR §1.97(e)) after the later of three months from the application's filing date and the mailing date of the first Office Action on the merits, but before a Final Office Action or Notice of Allowance (whichever is earlier), and therefore a check for the fee of \$200.00 under 37 CFR §1.17(p) is attached. Please charge any necessary fee or credit any overpayment in connection with this Information Disclosure

Statement to Deposit Account No. 19-4880. A duplicate copy of this paper is attached.

The filing of this Information Disclosure Statement may reflect an excess of caution because the cited U.S. Patent 5,254,799 already has been brought to the Examiner's attention by Adang, and because it is not prior art to Adang as Adang believes the instant application is entitled to the benefit of its 1983 filing date.^{1/} (The cited U.S. Patent 5,371,096 is merely a divisional of U.S. Patent 5,254,799).

In any event, a summary of the relevant communications, as relayed to the undersigned by Mr. Jeff Lloyd, Esq., Mycogen's outside patent counsel, follows:

By April, 1993 Mycogen and Mr. Lloyd had heard through industry contacts Plant Genetic Systems, N.V. (PGS) was assignee on a pending U.S. application filed by Degreve et al. (the "Degreve application") in which there were claims directed to plants which have been transformed to express *Bacillus thuringiensis* δ -endotoxins. On August 19, 1993 Mr. Lloyd contacted the Examiner by telephone to inquire about the status of the Adang application involved in this interference, because prosecution had been suspended and a claim had been suggested for copying pending a possible interference. The Examiner indicated that a new office action would be forthcoming and a new claim suggested for purposes of interference.

^{1/}See Adang's Motion for Benefit filed simultaneously herewith.

At this time Mr. Lloyd mentioned that Mycogen had heard there was a PGS application pending in which there were claims directed to transformed, insect resistant plants, reportedly similar to those disclosed and claimed in the involved Adang application.

On September 1, 1993, after receiving a new office action containing a revised claim suggested for copying, Mr. Lloyd once again telephoned the examiner for a telephonic interview regarding the status of the case and the possibility of scheduling an interview at the Patent Office. During this telephone interview Mr. Lloyd again mentioned the rumored PGS application.

Finally, during an October 13, 1993 interview at the Patent Office with the Examiner and her supervisory patent examiner, Mr. Lloyd mentioned that Mycogen had heard that the PGS application disclosed the use of truncated *Bacillus thuringiensis* genes in plants, and it was pointed out to the examiner that the original September 1983 Adang application also disclosed a truncated *B.t.* gene for insertion into a vector to transform plants. By October 26, 1993 Mr. Lloyd received a copy of the PGS file history for U.S. Patent No. 5,254,799 which contained claims to plants transformed with a truncated *B.t.* gene, and Mr. Lloyd noted that the Examiner examining the involved Adang application had been the primary examiner on the Degreve application. Mr. Lloyd subsequently copied a number of claims from the patent (see for example Adang's Claim 61) and notified the examiner.

Nonetheless, the examiner did not cite the Degreve application as prior art against Adang, apparently because Adang is entitled to

its 1983 filing date, and Degreve was not made a party to this interference.

The submission of the listed documents is not an admission that any such document constitutes prior art against the claims of the present application. Adang does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

Respectfully submitted,



Thomas J. Macpeak
Registration No. 19,292

SUGHRUE, MION, ZINN,
MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3202
(202) 293-7060

Date: July 1, 1994

CERTIFICATE OF SERVICE

A copy of the foregoing INFORMATION DISCLOSURE STATEMENT PURSUANT TO 37 C.F.R. §§1.197 and 1.198 and TWO REFERENCES was this first day of July, 1994, served on attorneys for Fischhoff et al. as follows:

(1) by mailing a copy via Federal Express (weekday morning) to:

Dennis R. Hoerner, Jr., Esq.
Monsanto Company
700 Chesterfield Village Parkway
St. Louis, Missouri

and to:

Roger W. Parkhurst, Esq.
Parkhurst, Wendel and Rossi
1421 Prince Street, Suite 210
Alexandria, Virginia 22314

DATE: July 1, 1994

BY:

Joseph P. Lange
Joseph P. Lange